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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/458,415 | 12/10/1999 | KEVIN GILLESPIE | 06129-156001 | 8818 |

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 04/23/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/458,415 | GILLESPIE, KEVIN |
| | Examiner | Art Unit |
| | Anthony D Stashick | 3728 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 and 47-76 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 - 5) Claim(s) _____ is/are allowed.
 - 6) Claim(s) 1-8 and 47-76 is/are rejected.
 - 7) Claim(s) _____ is/are objected to.
 - 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 February 2002 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 06 December 2001 is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: reference number 54', as shown in Figure 3, is not recited in the specification. Correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomat 6,092,251. Tomat '251 discloses all the limitations of the claims including the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region and including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA, or TPU, all known for cushionability and impact resistance.); inner member is within about 2 mm of back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figure 5-7);

intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above in view of Patterson et al. 6,176,025. The reference as applied to claim 1 above discloses all the limitations of the claims except for the inner member containing liquid or air. Patterson et al. '025 teaches that a cushion used in cushioning the heel of a user's foot while in a shoe can be made of a bladder-like material that contains air, gel, or any fluid to aid in distributing the impact forces of the user's foot with the ground. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made, to make the inner member of the reference as applied to claim 1 above out of a bladder containing air, liquid, or gel, as taught by Patterson et al. '025, to aid in cushioning the impact of the user's foot with the ground and to better distribute the impact over the user's foot during the gait cycle.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above in view of Lennihan, Jr. 5,875,568. The reference as applied to claim 1 above discloses all the limitations of the claim except for the outer member having a back wall that has a rounded contour extending smoothly between a horizontal plane and a vertical plane. Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that

smoothly transitions from a horizontal plane to a vertical plane (See Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make back wall of the outer member of the reference as applied to claim 1 above rounded so that it smoothly transitioned between a horizontal plane and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

7. Claims 47, 49-59, 61-65 and 67-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Turner Des. 417,946. Tomat '251 discloses all the limitations substantially as claimed including the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region and including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA, or TPU, all known for cushionability and impact resistance.); inner member is within about 2 mm of back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figure 5-7); intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-2). Tomat '251 does not teach the use of grooves and ridges. Turner '946 shows that grooves and ridges (seen in the Figures) can be located on the outer ground contacting surface of the sole. These grooves and ridges are shown as being located in the forefoot and heel regions of the sole and being substantially parallel to one another while being transverse and perpendicular to the longitudinal axis of the sole. The grooves and ridges are also shown to be located on the upper portion of the outer

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sole (as seen in Figure 3, the ride up the side of the sole) and extend to the edges of the outer sole. Therefore, it would have been obvious to place grooves and ridges, such as that shown in Turner '946, on the ground contacting portions of the sole of Tomat '251, that located on the inner member and the intermediate member, to allow for better flexibility of the sole and to allow for better grip of the sole with the ground that it contacts.

8. Claims 60, 66, 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Tomat 6,092,251 in view of Turner Des. 417,946 as applied above further in view of Lennihan, Jr. 5,875,568. Tomat '251 in view of Turner '946 discloses substantially all the limitations of the claims as noted above except for the outer member having a back wall that has a rounded contour extending smoothly between a horizontal plane and a vertical plane. Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (See Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make back wall of the outer member of Tomat '251 in view of Turner '946 as applied above rounded so that it smoothly transitioned between a horizontal plane and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

9. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Turner Des. 417,946 and Lennihan, Jr. 5,875,568. Tomat '251 discloses the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region an including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA, or TPU, all known for

cushionability and impact resistance.); inner member is within about 2 mm of back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figure 5-7); intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-2). Tomat '251 does not teach the use of grooves and ridges or the smooth transition of the back wall of the outer member from a horizontal plane to a vertical plane.

Turner '946 shows that grooves and ridges (seen in the Figures) can be located on the outer ground contacting surface of the sole. These grooves and ridges are shown as being located in the forefoot and heel regions of the sole and being substantially parallel to one another while being transverse and perpendicular to the longitudinal axis of the sole. The grooves and ridges are also shown to be located on the upper portion of the outer sole (as seen in Figure 3, the ride up the side of the sole) and extend to the edges of the outer sole. Therefore, it would have been obvious to place grooves and ridges, such as that shown in Turner '946, on the ground contacting portions of the sole of Tomat '251, that located on the inner member and the intermediate member, to allow for better flexibility of the sole and to allow for better grip of the sole with the ground that it contacts.

Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (See Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make back wall of the outer member of Tomat '251 in view of Turner '946 as applied above rounded so that it smoothly transitioned between a horizontal plane and

a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

10. Claim 76 is rejected under 35 U.S.C. 103(a) as being obvious over Tomat 6,092,251 as applied to claim 1 above. Tomat '251 as applied to claim 1 above discloses all the limitations of the claim except for the inner member being a softer durometer than the intermediate member. It is well-known in the art of feet cushions that the area of greatest impact, i.e. the heel area, should be made of a softer material than the other cushioning areas since it take the brunt of the impact of the user's foot. This would allow for appropriate cushioning of the heel without impacting the other areas of the user's foot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the heel member of Tomat '251 softer than the intermediate member to allow for better cushioning of the heel without detracting from support of the arch and metatarsal areas of the foot.

Response to Amendment

11. The Declaration of Dr. Edward Mostone filed on December 6, 2001 under 37 CFR 1.131 has been considered but is ineffective to overcome the prior art references. The declaration, in effect, states that baby feet are different than that of "normal adult feet" and therefore the gait of the infant is different than that of a "normal adult foot". It is unclear how this declaration affects the structure claimed and met by the prior art of record used in the rejections above. The prior art used discloses all the structural limitations of the claims and therefore, meets the limitations of the claimed invention.

12. With respect to applicant's arguments that the prior art of record does not disclose a shoe sole for a baby shoe (or for use in a baby shoe), this argument is not clearly understood. The prior art of record discloses a sole for use in a shoe, regardless of the size of the shoe, and therefore, since the structural limitations claimed are met by the prior art of record, the rejections above are proper. With respect to applicant's argument that the prior art recited are designed for adults, pointing out that the

outsole is inflexible and the insole is bulky as well as studded soles, footbeds and thick rounded soles, this argument is not clearly understood. Although the prior art may contain the structural characteristics listed by the applicant, the prior also contains the claimed structure of the instant application as well. Therefore, since the structure of the claims is such that it allows for the shoe sole to comprise more than that which is claimed, the prior art would be allowed to have more than that which is claimed by the applicant and still meet the limitations of the claimed subject matter since it has those limitations included within it. It has been well settled that a change in size and shape of an invention that is already known in the art does not lead to patentability. The mere stating that the sole claimed by the applicant is intended to be used for a baby shoe, rather than structurally defining the invention of the instant application over the prior art, does not lead to patentability.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining

groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

| | |
|---------------------------------|---------------------|
| Allowed Files & Publication | (703) 305-8322 |
| Assignment Branch | (703) 308-9287 |
| Certificates of Correction | (703) 305-8309 |
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| Fee Increase Questions | (703) 305-5125 |
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| Petitions/Special Programs | (703) 305-9282 |
| Terminal Disclaimers | (703) 305-8408 |
| Informal Fax for 3728 | (703) 308-7769 |

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line 1-800-786-9199
Internet PTO-Home Page <http://www.uspto.gov/>



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS
April 18, 2002